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| EXAMINER |
|---|
| LUKTON, DAVID |

| ART UNIT | PAPER NUMBER |
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| 1653 | 15 |

DATE MAILED: 02/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. 09/727,236 | Applicant(s) Linderman |
|---|---|---|
| | Examiner David Lukton | Art Unit 1653 |

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on *Dec 18, 2002*.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) *1, 2, and 4-60* is/are pending in the application.

4a) Of the above, claim(s) *15-60* is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1, 2, and 4-14* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

Pursuant to the directives of paper No. 14 (filed 12/18/02), claim 1 has been amended, and claim 3 cancelled. Claims 1, 2, 4-60 remain pending; claims 15-60 remain withdrawn from consideration. Applicants' arguments filed 12/18/02 have been considered and found not persuasive

*

The following is a quotation of the first paragraph of 35 U.S.C. §112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 2, 4-14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As indicated previously, applicants have proposed that the compounds (to which the claims are drawn) inhibit insect propagation by a process in which esterase biosynthesis is inhibited by a process which begins with stimulation of the TMOF receptor. However, there is no evidence that the TMOF receptor is affected one way or another by the compounds, or that esterase biosynthesis is affected one way or another by the compounds. In addition, it remains unknown at this time whether insect propagation is in any way altered.

As stated in *Ex parte Forman* (230 USPQ 546, 1986) and *In re Wands* (8 USPQ2d 1400, Fed. Cir., 1988) the factors to consider in evaluating the need (or absence of need) for "undue experimentation" are the following: quantity of experimentation necessary, amount of direction or guidance presented, presence or absence of working examples, nature of the invention, state of the prior art, relative skill of those in that art, predictability or unpredictability of the art, and breadth of the claims. As it happens, in the pursuit of insecticides, structure/activity relationships are unpredictable, and many insects are resistant.

- The following references disclose that insects develop resistance. Some of the references disclose that increased esterase activity is one of the mechanisms:

  Lee, Sung-Eun (*Agricultural Chemistry and Biotechnology* **44**(3), 105-112, 2001)

  Field, L. M. [Biochemical Sites of Insecticide Action and Resistance (2001), 209-219. Editor(s): Ishaaya, Isaac. Publisher: Springer-Verlag, Berlin, Germany]

  Devorshak, Christina (*Reviews in Toxicology (Amsterdam)* 2(7,8), 501-537, 1998)

  Wilkins, R. M. (*Brighton Crop Protection Conference--Pests and Diseases* (vol. 2), 511-516, 1998)

  Feyereisen, R. (*Toxicol. Lett.* (1995), 82/83(1-6), 83-90, 1995)

In addition to the foregoing, the following references disclose either(a) that compounds may be highly effective against some insects, but not others, or (b) that minor structural changes can eliminate activity:

- Inoue (USP 4752417) discloses (col 1, line 19+) that a change at one chiral center

can eliminate insecticidal activity.

- Wolfe(USP 4,342,176) discloses (col 2, line 58) that a given insecticide may be highly active against one insect species and inactive against another.

- Stehrer-Schmid, Paula (*Mutation Research* **339**(1), 61-72, 1995) discloses that three 2,3-dihydro-2,2- dimethylbenzofuran derivs. without a carbamate function are inactive.

- Kay, I. R. (*Crop Prot.* **12**(4), 310-14, 1993) discloses that Diazinon, carbofuran and dimethoate were ineffective against the eggfruit caterpillar (*Sceliodes cordalis*).

- Yamauchi, Satoshi (*Biosci., Biotechnol., Biochem.* **56**(11), 1760-8, 1992) discloses that the 3,4-dimethoxyphenyl analog was totally inactive, even at a high dose level.

- VanWagenen, Bradford C. (*J. Org. Chem.* **58**(2), 335-7, 1993) discloses that a structurally related compound, di-Me N2-creatininylphosphate (II), was inactive in the insecticidal screens.

- Yoshikawa, Hiromichi (*Biosci., Biotechnol., Biochem.* **56**(9), 1467-9, 1992) discloses that the 6-nitro derivs. were completely inactive as insecticides.

- Kole, Ramen K. (*J. Agric. Food Chem.* **40**(7), 1208-10, 1992) discloses that rotenone was very active, but dehydrorotenone was found to be completely inactive

- Dhingra, Swaran (*J. Entomol. Res.* **14**(2), 139-41, 1990) discloses that lindane and malathion were ineffective against the mealy bug.

- Mitsudera, Hiroyuki (*Nippon Noyaku Gakkaishi* **16**(3), 387-95, 1991) discloses analogs of nereistoxin that are insecticides. Also disclosed is that minor structural changes eliminated activity.

- Carmellino, M. L. (*Boll. Chim. Farm.* **129**(5), 190-4, 1990) discloses insecticidal activity of quinolinecarboxylic acids, as well as minor structural variants that are inactive.

In addition, applicants have proposed that the compounds may act by stimulating the TMOF receptor. Each of the following references discuss the issue of receptor activation (or receptor antagonism) versus *in vivo* activity. As it happens, the relationship between the two is "unpredictable":

- Torsello, Antonio (*Endocrinology* **143** (5) 1968, 2002) pertains to growth hormone, and discloses that stimulation of the growth hormone secretagogue receptor does not correlate with capability to stimulate GH secretion.

- McFadyen "Modifications of the cyclic mu receptor selective tetrapeptide Tyr-c[D-Cys-Phe-D-Pen]$NH_2$ (Et): effects on opioid receptor binding and activation" (*Journal of Peptide Research* (2000 Mar) 55 (3) 255-61) reported on modifications to the title peptide. The reference discloses that potency changes did not always correlate with affinity, suggesting that the conformation required for binding and the conformation required for activation of the opioid receptors are different.

- Keith , "mu-Opioid receptor internalization: opiate drugs have differential effects on a conserved endocytic mechanism in vitro and in the mammalian brain" (*Molecular Pharmacology* **53** (3) 377-84, 1998) discloses that the different effects of individual agonists are not correlated with their potencies for receptor activation and that a variety of clinically important agonists differ significantly in their relative abilities to stimulate the rapid internalization of opioid receptors.

- Xiao (*Biochemistry* **40**, 2860, 2001) has looked at the relationship between cAMP production in cells, and *in vivo* activity. While some degree of correlation was noted, a 1:1 correspondence was absent. As stated on page 2864, col 2, "the results indicated that these functions may be dissociated, mostly likely to additional determinantants of *in vivo* activity...". For example, as conveyed in table 6, Phe'-GLP-1 exhibited decreased receptor activation compared with WT GLP-1 along with decreased *in vivo* insulinotropic activity; by contrast, Acetyl-GLP-1 exhibited decreased receptor activation compared with WT GLP-1 accompanied by an increase in *in vivo* insulinotropic activity. Thus, receptor activation is not necessarily predictive of *in vivo* activity.

- Lunec, "MSH receptor expression and the relationship to melanogenesis and metastatic activity in B16 melanoma" (*Melanoma Research* (1992 May) 2 (1) 5-12) compared the effects of different pro-opiomelanocortin (POMC) peptides on melanogenesis and metastasis and their relationship to MSH receptor expression in B16F1 melanoma cells. The authors disclose that the relative binding affinities of the different peptides, measured by displacement of [125I]-Nle4-D-Phe7-alpha-MSH, did not closely correlate with the relative potencies in stimulating melanogenesis and metastasis. This suggests that receptor activation and the subsequent biological response is not determined solely by binding affinity.

Accordingly, "undue experimentation" would be required to determine which, if any, of the claimed compounds can be used to inhibit esterase biosynthesis or to inhibit propagation of insects.

In response to the foregoing, applicants have commented on each of the "Wands" factors, and have argued that, in spite of these factors, one can nevertheless conclude that the claimed invention is enabled. Applicants have begun their discussion of the "Wands" factors by pointing out that the "breadth of the claims" is not excessive. This particular point is not challenged, but applicants have gone on to argue that because the "breadth of the claims" is not unreasonable, this factor ("breadth of the claims") weighs in applicants favor. However, applicants are not correct with respect to this point. This factor is neutral at best. The fact is not not a single one of the claimed embodiments is enabled. Were it the case that applicants had shown that one of the compounds within the genus of claim 1 were indeed effective to inhibit propagation of insects, then it could be argued that

extrapolation to the full scope of the genus of claim 1 would not be unreasonable. But as matters currently stand, it makes little difference whether claim 1 encompasses a method of using one compound, 100 compounds, or 20 billion compounds. The degree of enablement in each case is the same; specifically, it is nonexistent.

Next, applicants have commented on the "nature of the invention" and have argued that an unidentified person or perhaps a group of persons has decided that when an applicant claims a method of using compounds, rather than compounds *per se*, examiners are required to abstain from imposing a scope rejection, or at least that examiners are supposed to be less insistent on a reduction of scope than would be the case if the compounds *per se* had been claimed. However, applicants have provided no insight as to the origins of such a notion.

If there is a generalization which can be made, it would be that the "hurdles" which must be overcome in establishing enablement of a method of use are actually greater than is the case for establishing enablement of compounds *per se*. In any case, the "nature of the invention" factor does not weigh in applicants' favor. Were it the case that applicants were claiming a table, or a chair or a screwdriver or a can opener, the "nature of the invention" might then be such as to weigh in applicants favor, since enablement for such inventions can often be ascertained by inspecting the invention itself. Not so in the case of a compound which has been asserted to stimulate receptors or inhibit enzymes or inhibit the propensity of an organism to reproduce.

Next applicants have commented on the "state of the art" and have argued that the field of insecticides is well developed, and that there exists a "vast body of [references]" on the subject. Certainly, it is true that there is a large body of literature on insecticides. But the question is not so much the volume of the literature as its relevance to the specifics of the claimed invention. If one looks at the universe of compounds which have been shown to stimulate TMOF or to inhibit esterase biosynthesis, and which compounds, at the same time, mitigate insect fertility, one is left with little more than a small handfull of references. Of those few references that may exist, not a single one even mentions any of the claimed compounds. Thus the references on insecticides which do exist are of little help in instructing the skilled entomologist how to avoid the expenditure of "undue experimentation" in endeavoring to find conditions under which insect propagation can indeed be inhibited. The "state of the art" does not weigh in applicants favor at all. Applicants have next commented on the "level of ordinary skill" in the field of entomology. Applicants have argued that the level of skill at issue is very high, and that practitioners would have the capacity to design experiments, carry them out, and interpret the results. This particular point is not in dispute. Applicants have gone on to argue that such a high level of expertise weighs in applicants favor. Applicants are not correct. Whether the field at issue is nuclear physics or aerospace engineering or biomedical engineering or entomology, the fact is that there always exists problems sufficiently difficult that the very

best and brighest in the field are challenged, if not overwhelmed, by the pursuit of solutions to those problems. It is true that the skilled entomologist would be able to design experiments on the propensity of a compound to stimulate the TMOF receptor, or to inhibit esterase biosynthesis. But if a compound is destined to have no effect on the TMOF receptor, or on esterase biosynthesis, no amount of experimentation on the part of the experienced entomologist will be sufficient to achieve stimulation of the receptor or inhibition of the biosynthesis. If there exists a wide "window of opportunity" for the achievement of success, then the skilled scientist may be able to solve the problem at hand. But if the "window of opportunity" for the achievement of success is vanishingly small or nonexistent, no amount of skill or experience will be sufficient. The fact that the "level of skill" may be high does not weigh in applicants favor.

With respect to the matter of unpredictability, applicants have conceded that this particular factor does not weigh in applicants favor. However, applicants have argued that the fact of unpredictability, in and of itself, is not sufficient to establish a requirement for undue experimentation. While this may be true, it is the most important factor when working examples are absent.

With respect to the "amount of direction" provided, applicants have asserted that they have provided "considerable" direction. However, applicants are not correct. What applicants have provided is speculation, specific though it may be. Suppose that the

examiner were to make the following assertion:

> Administration of 4.73 mL of a 0.93% saline solution i.v. to a white male, age 59, weighing 172.49 kg and afflicted with pancreatic cancer will be effective to reduce the tumor volumes by 78.3% if adminstered 4 times per day for 121 days.

Applicants would have to concede that this assertion is specific; but is it persuasive? The point is that one should not confuse the specificity of information with the quality or significance of that information. Applicants' speculation regarding dosages and susceptible insects may be specific, but no amount of specificity is sufficient to make the transition from speculation to evidence.

Next, applicants concede that no "working examples" have been provided. Applicants have gone on to argue that *In re Strahilevitz* (212 USPQ 561) "immunizes" applicants from any assertion on the part of examiners that a working example is required to satisfy the enablement requirement. Applicants have further argued, without identifying any specific passage in the opinion, that such "immunity" from rejection based on lack of working examples extends beyond "predictable" subject areas into "unpredictable" subject areas.

*Strahilevitz* pertained to what is now USP 4375414. The broadest claim under appeal was the following:

> An immunological method for removing from a living mammal a hapten in the blood of said mammal, comprising connecting in the blood circulatory system of said mammal a hapten-removing device, said device comprising passage means for said blood; an antibody to said hapten in said device; and exposure means in said device for

exposing said hapten to said antibody and for preventing said antibody from entering said circulatory system.

In response, the examiner would make two points: (a) there appeared to be no effort on the part of the examiner during prosecution to assert obviousness based on the closest prior art, thereby imposing on applicants the burden of establishing novelty, and (b) there appears to be no attempt on the part of the examiner to provide evidence of non-enablement. With respect to the first point, consider the following hypothetical claims:

100. A method of treating diabetes comprising administering to a patient in need thereof human insulin for a time and under conditions effective to increase uptake of glucose.

101. A method of treating a headache comprising administering aspirin to a patient in need thereof for a time and under conditions effective to mitigate the sensation of pain.

102. A television set which can receive and display video and audio signals, wherein imprinted on said television set are eight "polka dots" of 1.765 cm each, green in color, and 12 "polka dots" of 1.352 cm each, purple in color.

It is submitted that if an applicant were to submit any of the foregoing claims, an enablement rejection would be improper, even if no "working examples" were provided. The reason is that the "state of the art" is such that the skilled artisan would recognize that each of these inventions is enabled. In the case of claim 101, even persons lacking any medical training are aware that aspirin can sometimes be effective to treat headaches. In the case of claim 102, it should be clear to persons with no technical training that they could simply paint the "polka dots" on their own television set. Thus, it is within the realm of possibility that

a situation could arise in which an enablement rejection based solely on the absence of working examples would be improper. In the foregoing examples, however (claims 100-102), the question of enablement would be entirely moot, since the claims are unpatentable. Turning back to the facts of *Strahilevitz*, it appears that the Court came close to implying that the claimed invention is obvious. The opinion draws focus to various prior art methods referred to by applicants which the skilled immunoassay specialist would be able to bring together in the practice of the claimed invention. Had the examiner fashioned a §103 rejection based on the references cited by applicants, or references which came even closer to disclosing the claimed invention, the whole issue of enablement might well have been rendered moot. Whether or not this is true cannot be said with certainty based on the facts of record; the point is, however, that **if** a claimed invention would have been obvious to one of ordinary skill at the time of filing, a rejection based upon lack of working examples would generally not be appropriate. Another point to be made about *Strahilevitz* is that the examiner presented no evidence of "unpredictability" relevant to the claimed invention. For example, perhaps it was known at the time of the invention (1971) that antibodies would bind to haptens under carefully controlled conditions in a test tube, but that if one replaced the aqueous buffers (present in the test tube) with whole blood, antibody/hapten recognition was often reduced, or even eliminated. Had such references been brought to the fore by the examiner, the enablement rejection might well have been affirmed. Of course, it is

not the case that all claimed inventions are unpredictable; the point is just that this particular one **may** have been. Thus, it appears that two issues critical to the question of patentability were not raised by the examiner, i.e., obviousness and unpredictability. Applicants might choose to argue that enablement and obviousness are unrelated to one another. However, as acknowledged by applicants, one of the factors to consider in evaluating the requirement for "undue experimentation" is the "state of the art". As it happens, the "state of the art" is not identical to 35 USC §103, but when a claimed invention is obvious over the prior art, two realities generally come into play: (a) the claimed invention is enabled, but (b) the claims are nevertheless unpatentable. Turning back to applicants point about *Strahilevitz*, applicants have somehow come to the conclusion that the Court endorsed the proposition that working examples are not required, even in unpredictable arts. However, applicants are not correct. If evidence of unpredictability has been presented, and if the invention at issue is novel, it is more often than not the case that the absence of a working example is a substantial impediment to a finding of enablement.

Finally, applicants have argued that the skilled entomologist is able to conduct experiments on the propensity of a compound to inhibit proliferation of insects. However, if the claimed compounds do indeed have no effect on the TMOF receptor, or on esterase biosynthesis, no amount of experimentation on the part of the experienced entomologist will be sufficient to achieve stimulation of the receptor or inhibition of the biosynthesis. For

example, suppose an applicant were to assert that injecting saline into tumor-bearing rats would cause significant reduction of the tumor volumes. Certainly, it is a simple matter to inject rats with saline; in fact, it requires no scientific training. But does the fact that injecting rats with saline is easy mean that the injections will be effective? As it happens, if a compound is ineffective to function in the matter that has been asserted, no experimental protocol is sufficiently easy to carry out such that "undue experimentation" can be avoided. Applicants have argued that inhibition of insect propagation can be achieved with nothing more than routine experimentation. If this reflects applicants view on the matter, it is suggested that such routine experimentation be undertaken, and the results presented.

In accordance with the foregoing, "undue experimentation" would be required to determine which, if any, of the claimed compounds can be used to inhibit esterase biosynthesis or to inhibit propagation of insects. In addition, "undue experimentation" would be required to achieve killing of insects in the field, as mandated by the term "insecticidally effective".

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Claims 1, 2, 4-14 are rejected under 35 U.S.C. §112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Many of the dependent claims (e.g., claim 2) recite the phrase "said pest". This term lacks antecedent basis. Applicants have argued that claim 1 has been amended to

overcome this rejection. However, while claim 1 has been amended, the amendments to this claim do not pertain to the issue of the phrase "said pest".

- Claim 1 is indefinite as to the process steps and endpoint. Applicants have argued that the endpoint is provided by the phrase "insecticidally effective". However, this is not the case. Suppose that at some point in the future applicants were to provide evidence that that the compounds inhibit biosynthesis of a serine esterase. The question at that point would become the following: Suppose that applicants were presented with two groups of insects. Group #1 was treated with a compound of formula IA or IB, but the amount of the compound administered, and the time period of administration were not quite sufficient to perceptibly inhibit biosynthesis of a serine esterase. The insects in Group #2, on the other hand, were treated with an amount of the compound, and for a time and under conditions such that biosynthesis of a serine esterase was clearly inhibited. If applicants were presented with these two groups of insects, how would applicants go about determining which group had been treated with a compound in accordance with the asserted objective? Would applicants give any consideration to the issue of esterase biosynthesis, would applicants look at changes in the behavior of the insects, or in the appearance of the insects, or some other variable? It is not sufficient to merely argue that other entomologists are free to make their own determination. The question is, what would applicants regard as a necessary and sufficient indicator that administration of the compound produced an outcome consistent with the claimed invention?

  There is a related issue which is that of the mismatch between "inhibiting propagation" (on the one hand), and causing death of the insect (i.e., "insecticide") on the other hand. This situation can be illustrated by the following example. Suppose that an applicant were claiming a method of decreasing fertility of a human female.

  The applicant submits the following claim:

  *A method of decreasing fertility of a human adult female comprising administering compound "X" for a time and under conditions effective to cause the death of said human adult female.*

  Clearly, no one would want to claim such a method. But this is (according to one interpretation) what applicants are claiming, except that it is applied to insects, rather than humans. Instant claim 1 recites a method for inhibiting propagation of an insect, but at the same time, mandates that the very insect endeavoring to propagate

must be killed (i.e., "insecticide"). Thus, at best, one can say that claim 1 lacks clarity.

In the event that applicants have shown that the compounds inhibit biosynthesis of a serine esterase, it is suggested that the claims be amended to recite that the time and conditions are indeed effective to accomplish this objective, i.e:

*100. A method for inhibiting propagation of insects comprising administering to said insects a compound of formual IA or formula IB*
*{formulas as recited}*
*for a time and under conditions effective to inhibit biosynthesis of a serine esterase... [etc.]*

On the other hand, if applicants have shown that the compounds stimulate the TMOF receptor, it is suggested that the claims be amended to recite that the time and conditions are indeed effective to accomplish this objective, i.e:

*101. A method for inhibiting propagation of a insects comprising administering to said insects a compound of formual IA or formula IB*
*{formulas as recited}*
*for a time and under conditions effective to stimulate the trypsin modulating oostatic factor (TMOF) receptor...[etc.]*

If applicants have shown that the compounds do indeed reduce the rate of reproduction of certain insects, then other claim language may be appropriate. Applicants have also argued that some other examiners have abstained from rejecting the term "insecticidally effective". However, the question of compliance with the patent laws is not determined by the actions of another examiner in another application. In application 09/727236, if a rejection is valid, the actions of other examiners in other applications are not controlling. Nevertheless, if applicants can demonstrate that death of a given group of insects is an inevitable consequence of contacting those insects with a compound of formula IA or IB, then at least in principle, it should be possible to fashion claim langauge which incorporates the phrase "insecticidally effective" without violating the mandates of §112, first and second paragraphs.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 703-308-3213. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, can be reached at (703) 308-2923. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

DAVID LUKTON
PATENT EXAMINER
GROUP 1600